REMARKS/ARGUMENTS

Claims 1-27 are pending in this application. Claims 1-3, 5-14, 16-20, and 22-26 have been amended. Claims 1, 12, 19, and 25 are independent claims.

Applicant kindly requests favorable reconsideration of the application in view of the amendments and the following discussion.

Support for Amendments

Support for each of the amendments is found in the specification. Independent claims 19 and 25 were amended to more clearly define the invention. The added limitation "wherein the index information is structured for use in an index database of a search engine system," is disclosed in the specification in paragraphs 0047, 0007, and 0045. Paragraph 0047 discloses that search engine systems have an index database containing index information from surveyed data objects. Paragraph 0007 discloses that index information used for a search engine system has a specific structure. Paragraph 0045 discloses that a search engine system is a type of information retrieval system.

The added limitations of "reading index information that is associated with a secure graphical or audio object," and "wherein the secure graphical or audio object is secure in that the search engine system does not have full access to the secure graphical or audio object" are disclosed in the specification in paragraphs 0008-0009. Secure documents or objects are data protected by digital rights management (DRM) software or systems. DRM systems prevent search engine systems from having full access to such objects for preparing index information.

The added limitation of "transmitting the electronic document to the search engine system, wherein the index information within the electronic document is for use in the index database of the search engine system" is disclosed in the specification in paragraph 0045, 0048, and in original claim 12. Paragraph 0045 discloses that a search engine system is a type of information retrieval system, paragraph 0048 discloses and original claim 12 claimed transmitting index information to an information retrieval system.

Independent claims 1 and 12 have been amended similarly to how independent claims 19 and 25 were amended. Thus, support for the amendments to claims 1 and 12 is

the same as the support described above for claims 19 and 25. The dependent claims that were amended were principally amended to describe the graphical and audio objects as "secure" objects, as disclosed in paragraph 0008. Other amendments to the dependent claims are similar to amendments to the independent claims and are described above.

Claims 19 & 25

The Examiner has asked the Applicant to show that claims 19 and 25 are patentable over Yamanaka in view of Sotomayor. As required, by M.P.E.P § 2143:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

The combination of Yamanaka and Sotomayor fails to establish a prima facie case of obviousness because the combination does not teach or suggest all the claim limitations as required by M.P.E.P § 2143.

The reference combination does not teach or fairly suggest several limitations in the claims. The reference combination is silent on "reading index information that is associated with a secure graphical or audio object." Neither Yamanaka nor Sotomayor mention the terms "secure" or "rights" or "protected." The reference combination is silent on index information "structured for use in an index database of a search engine system." Sotomayor does not mention the term "index information." Yamanaka discloses "index information," but not the type of index information structured for use in an index database of a search engine system. Instead, the index information of Yamanaka is merely information which indicates "the file identification number" for transmitting data (Yamanaka col. 13, lines12-17). The reference combination is silent on "wherein the secure graphical or audio object is secure in that the search engine system does not have full access to the secure graphical or audio object." Neither reference has any suggestion or indication of

relating to Digital Rights Management systems. The reference combination is silent on dynamically generating an electronic document with the type of index information claimed. Sotomayor discloses automatically generating an index, but this index is simply a table of contents (Sotomayor col. 1, lines 16-37) and not the type of index information claimed in the present invention. Finally, the reference combination is silent on transmitting the search engine index information to a search engine system. Neither reference, alone or combined, discloses or relates to search engines and compiling search engine databases. Thus, claims 19 and 25 are patentable over Yamanaka in view of Sotomayor. Claims 19 and 25 are therefore believed to be allowable for the above listed reasons.

In addition to the reference combination not teaching or suggesting all of the claim limitations, another reason why the reference combination fails to establish a prima facie case of obviousness is that there is no suggestion or motivation to modify or combine the reference teachings. Yamanaka relates to the problems associated with converting conventional-sized display images so that the images can be displayed on a wide screen TV or monitor (Yamanaka col. 1, lines 9-67). There is no reference in Yamanaka to secure data objects, search engine systems, or index information structured for search engine databases. Sotomayor relates to word processors and generating an index or table of contents for a text document. Likewise in Sotomayor there is no reference to secure data objects, search engine systems, or index information structured for search engine databases. There is no motivation for a person of ordinary skill in the art to combine an image re-sizer (Yamanaka) with a table of contents generator (Sotomayor) to solve the problems associated with making search engine index information for secure graphical or audio objects. Thus another reason why the claims are believed to be in condition for allowance is that there is no suggestion or motivation to combine Yamanaka with Sotomayor.

Claims 20-24, 26, & 27

The Examiner has asked the Applicant to show that claims 20-24, 26, and 27 are patentable over Yamanaka in view of Sotomayor. Claims 20-24, 26, and 27 each depend on one of independent claims 19 and 25. As discussed above, claims 19 and 25 are patentable over the reference combination because the cited references fail to teach or

suggest all the claim limitations, and because there is no motivation to modify or combine the references. The limitations of claims 19 and 25 are incorporated by reference in each of dependent claims 20-24, 26, and 27. If an independent claim is patentable, then all claims that depend therefrom are also patentable. Thus claims 20-24, 26, and 27 are also patentable over Yamanka in view of Sotomayor for the same reasons that claims 19 and 25 are patentable over the reference combination. Claims 20-24, 26, and 27 are therefore believed to be allowable.

Claims 1 & 12

The Examiner has asked the Applicant to show that claims **1** and **12** are patentable over Yamanaka in view of Durst, Jr.. As required, by M.P.E.P § 2143:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

The combination of Yamanaka and Durst, Jr. fails to establish a prima facie case of obviousness because the combination does not teach or suggest all the claim limitations as required by M.P.E.P § 2143.

The reference combination does not teach or fairly suggest several limitations in the claims. The reference combination is silent on "reading index information that is associated with a secure graphical or audio object" and "converting at least a portion of a secure audiovisual object into index information." Neither Yamanaka nor Durst, Jr. mention the terms "secure" or "rights" or "protected." The reference combination is silent on index information "structured for use in an index database of a search engine system." Durst, Jr. discloses "indexed information," but not the type of index information structured for use in an index database of a search engine system. Instead, the indexed information of Durst, Jr. is simply a file location index (Durst, Jr. col. 7, lines 51-54, and col. 8, lines 60-

62). Yamanaka discloses "index information," but also not the type of index information structured for use in an index database of a search engine system. Instead, the index information of Yamanaka is merely information which indicates "the file identification number" for transmitting data (Yamanaka col. 13, lines12-17). The reference combination is silent on "wherein the secure graphical or audio object is secure in that the search engine system does not have full access to the secure graphical or audio object." Neither reference has any suggestion or indication of relating to Digital Rights Management systems. The reference combination is silent on "obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced." Yamnanka is silent on obfuscating. Durst Jr. discloses the word "obfuscate," but teaches obfuscating user identification codes and not the index information of the claimed invention. Finally, the reference combination is silent on transmitting the search engine index information to a search engine system. Neither reference, alone or combined, discloses or relates to search engines and compiling search engine databases. Thus, claims 19 and 25 are patentable over Yamanaka in view of Durst, Jr. Claims 19 and 25 are therefore believed to be allowable for the above listed reasons.

In addition to the reference combination not teaching or suggesting all of the claim limitations, another reason why the reference combination fails to establish a prima facie case of obviousness is that there is no suggestion or motivation to modify or combine the reference teachings. Yamanaka relates to the problems associated with converting conventional-sized display images so that the images can be displayed on a wide screen TV or monitor (Yamanaka col. 1, lines 9-67). There is no reference in Yamanaka to secure data objects, search engine systems, or index information structured for search engine databases. Durst, Jr. relates to bar codes and RF-ID tags linking distributed data over the Internet. Likewise in Durst, Jr. there is no reference to secure data objects, search engine systems, or index information structured for search engine databases. There is no motivation for a person of ordinary skill in the art to combine an image re-sizer (Yamanaka) with a bar code reader (Durst, Jr.) to solve the problems associated with making search engine index information for secure graphical or audio objects. Thus another reason why the claims are believed to be in condition for allowance is that there is no suggestion or motivation to combine Yamanaka with Durst, Jr.

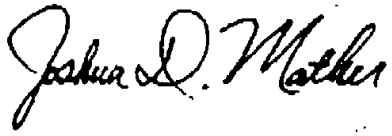
Claims 2-11 & 13-18

The Examiner has asked the Applicant to show that claims 2-11 and 13-18 are patentable over Yamanaka in view of Durst, Jr. Claims 2-11 and 13-18 each depend on one of independent claims 1 and 12. As discussed above, claims 1 and 12 are patentable over the reference combination because the cited references fail to teach or suggest all the claim limitations, and because there is no motivation to modify or combine the references. The limitations of claims 1 and 12 are incorporated by reference in each of dependent claims 2-11 and 13-18. If an independent claim is patentable, then all claims that depend therefrom are also patentable. Thus claims 2-11 and 13-18 are also patentable over Yamanaka in view of Durst, Jr. for the same reasons that claims 1 and 12 are patentable over the reference combination. Claims 2-11 and 13-18 are therefore believed to be allowable.

Summary

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,



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Date: 03-08-2005

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